Hearing: Paper No. 17
September 23, 1999 HRW

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re AT&T Corp.

Serial No. 75/228,615

Steven M. Weinberg of Weinberg Legal Group
for AT&T Corp.

Paula B. Mays, Trademark Examining Attorney, Law Office 114
(Mary Frances Bruce, Managing Attorney).

Before Hairston, Walters and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

AT&T Corp. has filed an application to register the mark MAKING THE INTERNET REALLY WORK FOR BUSINESS for "educational services, namely, providing conferences, seminars and training sessions relating to global computer information networks and telecommunications services."[1]

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[1] Serial No. 75/228,615, filed September 25, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the registered mark MAKING TECHNOLOGY WORK FOR BUSINESS for "computer consulting services, namely, computer software design for others, computer system analysis for others, computer programming for others and selection of computer equipment for others."[2]

Applicant and the Examining Attorney have filed briefs, and both participated in an oral hearing.

In any determination of likelihood of confusion, two key considerations in our analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the services with which the marks are being used. See In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999).

Here, the Examining Attorney takes the position that both marks create similar overall commercial impressions, namely, as slogans containing the phrase MAKING THE ...WORK FOR BUSINESS. She maintains that the terms INTERNET or TECHNOLOGY are descriptive words referring to "something having to do with computers" which would be least likely to be remembered by purchasers. Instead, both marks would be

[2] Registration No. 2,057,087, issued April 29, 1997, claiming first use dates of October 1, 1993.

viewed as offering services which will assist businesses in computer related fields.

Applicant contends that the Examining Attorney has placed the emphasis on the wrong features of the respective marks and failed to see the different commercial impressions the marks seek to convey. Applicant argues that consideration must be given to the specific services being offered by applicant and registrant and the resultant effects these services have on the commercial impressions created by the marks. Applicant argues that the message conveyed by its mark is that it is offering services which will show businesses how to use the Internet successfully whereas registrant's message is that it offers services to businesses related to using computer technology effectively. From applicant's viewpoint, the dominant features of the marks are those which identify the subject matter of the services, namely, THE INTERNET and TECHNOLOGY. Applicant argues that the distinctions between the connotations in these terms must be considered, namely, THE INTERNET as an information and communications source and TECHNOLOGY as computer technology tools.

It is true that in determining likelihood of confusion, even though marks must be considered in their entireties, it may be appropriate to give more or less

weight to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The present case, however, does not appear to be one in which one portion of the marks should be given more weight than another. While both marks share the phrase MAKING...WORK FOR BUSINESS, the intermittent words cannot automatically be relegated to descriptive, non-source indicating status. Instead, we must consider the particular services with which each mark is being used to determine the effect the services being offered will have upon the commercial impressions created by the marks as a whole. See Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988).

The Examining Attorney maintains that the services of applicant and registrant are closely related services in the field of computers and computer technology, particularly because applicant's services are educational and training services and registrant's services cover consulting services (which she contends may include education and training), as well as programming and design services. She further argues that the services are likely to travel in the same channels of trade and be offered to the same class of purchasers, namely, those in businesses.

Applicant insists that to blanketly describe the services of applicant and registrant as "computer related" is to ignore the distinct differences in the services offered. Applicant describes its services as educational in nature and relating to business use of the Internet (global computer information networks) and telecommunication services. Applicant states that it is not providing computer services or training about computer programming. Registrant's services are identified as being directed to the design and analysis of business software programs and assistance in selecting computer equipment. Applicant argues that any conclusion made by the Examining Attorney that registrant's services might also include education and training is totally without support. Similarly, applicant contends that the Examining Attorney has incorrectly assumed that the channels of trade and potential customers are the same. Even though both services are targeted to businesses, applicant argues that its training services in a particular communication medium are aimed at a different audience or different individuals within the business than those seeking consulting services on the design or programming of computers.

We agree with applicant that the services of applicant and registrant cannot be considered "closely related"

simply because the services in some way involve computers. See Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992) and the cases cited therein. Applicant's services involve educating business personnel in accessing and using telecommunications systems, particularly the Internet. Registrant's services, on the other hand, involve consulting with business personnel on matters of computer software design, computer system analysis, computer programming and selection of computer equipment. While applicant's educational services necessarily require the use of a computer to access the Internet, applicant's services, as identified in its application, do not involve any design or development of the computer systems used for this purpose. Registrant's services are those which are directed to the design and implementation of the computer systems for the business.

As such, we find the educational services of applicant and technology services of registrant to be far from "closely related." Furthermore, the fact that the identifications of services in the application and registration are without limitation as to channels of trade, coupled with the fact that the marks refer to business in general, does not provide an adequate basis for the Examining Attorney's presumption that the services

would travel in the same channels of trade or be targeted to the same purchasers. Instead, we are guided by the specific nature of the services as identified and what would inherently be the normal channels of trade for such services. Without any evidence to the contrary, we consider the differences between educational services with respect to use of the Internet for business purposes and consulting services with respect to the design of computer systems, even if utilized by the same businesses, to be sufficient that it would be highly unlikely that the same individuals within a particular business would be potential purchasers for both services. See Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992).

Accordingly, on the basis of the distinctions between the services offered under the marks MAKING THE INTERNET REALLY WORK IN BUSINESS and MAKING TECHNOLOGY WORK IN BUSINESS, we agree with applicant that the overall commercial impressions created by the marks, when viewed in connection with the proffered services, would be entirely different. We find there is no likelihood of confusion.

Decision: The refusal to register under Section 2(d) is reversed.

P. T. Hairston

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board